

REMARKS

Claims 14-18 are pending in the above-identified application, claims 1-13 and 19-20 having previously been canceled by Applicant without prejudice pursuant to a restriction requirement having been made final. Accordingly, claims 14-18 remain for consideration.

Claims 14-18 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

Claim 18 was rejected under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 5,631,012 to Shanni (“Shanni ‘012”).

Claims 14-15 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,866,145 to Stavroff (“Stavroff et al. ‘145”).

Claims 14-15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Great Britain Patent Publication No. 1,479,199 to Kligman (“Kligman (GB)”) in view of either one or both of Japan Patent Publication Abstract No. JP 08113530 (“Japan Abstract”) or U.S. Patent No. 4,943,432 to Biener (“Biener ‘432”).

Claims 14-15 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Stavroff et al. ‘145 in view of U.S. Patent No. 5,922,313 to Steward (“Steward ‘313”).

Claims 14-18 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Stavroff et al. ‘145 in view of Steward ‘313 and further in combination with U.S. Patent No. 5,827,870 to Chodosh (“Chodosh ‘870”).

Claims 14-18 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Kligman (GB) over Japan Abstract and Biener ‘432 by themselves or in combination, and further in view of Chodosh ‘870.

Reexamination of the application as amended, reconsideration of the rejections, and allowance of the claims remaining for consideration are respectfully requested.

The period for response has been extended until October 10, 2000 by the filing of a two-month Request for Extension of Time Under 37 C.F.R. § 1.136(a). Accordingly, this response is being filed in a timely manner.

This Response is being filed subsequent to a telephone interview with the Examiner held on August 21, 2000. The undersigned respectfully thanks the Examiner for the courtesy of this interview. This Response addresses the issues discussed in the interview.

I. AMENDMENTS TO THE APPLICATION

Entry of the amendments to the application is respectfully requested. As detailed below, these amendments introduce no new matter.

The amendments to the claims, except for claim 18, are made in response to the rejections under the second paragraph of 35 U.S.C. § 112. In particular, the second recitation of “non-oily” in claim 14 is deleted. Claim 14 is also amended to rewrite “mineral salt elements” as mineral salts.

Claims 16 and 17 are rewritten for clarity, using the transitional phrase “further comprising.” Claim 17 is also amended by placing a comma between the elements “lipocol” and “glycerin” to clarify that they are separate ingredients.

Claim 18 is rewritten to include both water and the non-oily base element, in addition to pumice. The use of water is shown in the Table at page 14 of the specification; pumice or silica can then be added to the resulting composition as shown at page 14, lines 22-23.

These amendments introduce no new matter and are fully supported by the specification. Accordingly, entry of these amendments is respectfully requested.

For the convenience of the Examiner and in compliance with recently-amended 37 C.F.R. § 1.121, Applicant has attached as a separate sheet a marked-up copy of the amendments, showing all changes relative to the previous version of the amended claims, with the additions identified by underlining and the deletions identified by brackets.

II. THE REJECTIONS UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

Claims 14-18 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite. To the extent that these rejections have not been obviated by the amendments to the application, they are respectfully traversed.

Specifically, the second recitation of “non-oily” in claim 14 is deleted. The term “non-oily” is clear in view of the specification. Although the salt will eventually dissolve in the hydrophilic component, it remains in granular condition while the composition is applied to the skin of the patient. This is clarified in the specification at page 3, lines 3-5. The salts recited are clearly defined in the specification, such as at page 5, lines 11-21. Claim 14 is also amended to rewrite the term “mineral salt elements” as mineral salts.

Claim 16 is rewritten to recite “scrubbing agent” as an additional element using the transitional phrase “further comprising”, eliminating any possible lack of antecedent basis.

Claim 17 is also rewritten to recite the transitional phrase as “further comprising” to clarify the scope of the claim.

Claim 17 is also amended to place a comma between the recitations of “lipocol” and “glycerin,” to make clear that these are distinct ingredients in the composition of the claim.

Accordingly, the Examiner is respectfully requested to withdraw these rejections.

III. THE PRIOR ART REJECTIONS

A. The Rejections Under 35 U.S.C. § 102(e)

1. The Rejections of Claims 14-15 as Anticipated by Stavroff et al. '145

Claims 14-15 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,866,145 to Stavroff et al. ("Stavroff et al. '145"). As detailed below, Stavroff et al. '145 has properly been removed as prior art by the declaration of Ron Lewis, dated July 29, 2000 ("Lewis Declaration").

It is well established that an anticipatory reference can be disposed of by a declaration or affidavit filed under 37 C.F.R. § 1.131 as long as the affidavit shows that Applicant was in possession of as much of the claimed invention as the reference teaches. In re Stempel, 113 U.S.P.Q. 77 (C.C.P.A. 1957). In In re Stempel, a claim to a genus of chemical compounds was rejected under 35 U.S.C. § 102 as anticipated by a reference that disclosed a particular species, species X, within the scope of the claimed genus. While the Applicant's showing by declaration or affidavit under 37 C.F.R. § 1.131 did not make out a *prima facie* case of possession of the entire genus, it did show completion of the invention of species X before its disclosure in the reference. That was held sufficient to remove the reference as prior art. Id. For convenience, a copy of the Stempel decision is included herein.

The showing made in the Lewis Declaration is sufficient to remove Stavroff et al. '145 as a reference in view of the holding of Stempel. "We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references [happen] to show. When he had done that he has disposed of the references." Stempel, 113 U.S.P.Q. at 81.

Moreover, if a compound or species described in a reference would have been obvious to one of ordinary skill in the art in view of what the affiant or declarant proves was completed with respect to the invention prior to the effective date of the reference, the reference is overcome as prior art. In re Clarke, 148 U.S.P.Q. 665 (C.C.P.A. 1966). A copy of the Clarke decision is also enclosed.

This is exactly the situation here with respect to Stavroff et al. '145. Stavroff et al. '145 teaches a genus that includes a Dead Sea salt and an emollient. Applicant, by way of the Lewis Declaration, has shown that it had prepared a composition containing Dead Sea salt and an emollient before the filing date of Stavroff et al. '145, January 28, 1997. The lipid soluble ingredients shown in the exhibit of photocopied page 108 to the Lewis Declaration include a number of ingredients that one of ordinary skill in the art would recognize as emollients. The specification shows, e.g., at page 7, line 21, that emulsifiers also serve as emollients. Thus, Applicant has shown that it had possession of the generic invention recited in Stavroff et al. '145 before the filing date of Stavroff et al. '145. This showing is sufficient to antedate the reference under the holdings of Stempel and Clarke, and the Examiner is therefore respectfully requested to withdraw this rejection and withdraw Stavroff et al. '145 as a reference.

The comments made at pages 3-4 of the Office Action that the instant claims are broader in scope than the compositions in the declaration is not a proper ground for failure to consider the declaration or failure to remove the reference in view of the holding in of In re Stempel. Such a relationship between the showing of the declaration and the scope of the claims is irrelevant under Stempel. All that is required is that the declaration shows as much of the invention as the reference shows, a standard that is met here.

2. The Rejection of Claim 18 as Anticipated by Shanni '012

Claim 18 was rejected under 35 U.S.C. § 102(a) as anticipated by U.S. Patent No. 5,631,012 to Shanni ("Shanni '012"). This rejection is believed to be obviated by the amendment of claim 18. To the extent that this rejection has not been obviated by the amendment of claim 18, it is respectfully traversed.

In paragraph 4 of the Office Action, it states that water is considered to be the non-oily base material. Claim 18, as amended, recites both water and a non-oily base material, which is distinct from water. Thus, claim 18, as amended, cannot be anticipated by Shanni '012, as anticipation requires that all of the elements of the claim be included in the disclosure of a single reference. Atlas Powder Co. v. E.I. du Pont de Nemours & Co., 224 U.S.P.Q. 409 (Fed. Cir. 1984).

Accordingly, this rejection has been obviated by the amendment of claim 18 and the Examiner is respectfully requested to withdraw it.

B. The Rejections Under 35 U.S.C. § 103(a)

1. The Rejection Over Kligman (GB) In View of One or Both of Japan Abstract and Biener '432

Claims 14, 15, and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Great Britain Patent Publication No. 1,479,199 to Kligman ("Kligman (GB)") in view of either one or both of Japan Patent Publication Abstract No. JP 08113530 ("Japan Abstract") or U.S. Patent No. 4,943,432 to Biener ("Biener '432").

This rejection is respectfully traversed, because there is no incentive to combine these references and yield the claimed invention. Japan Abstract teaches the use of seawater as an alternative to a composition including salts, which suggests that the salts in Japan Abstract are provided in a state in which they are in solution and not in the state that the salts are provided in the claimed composition. In view of this teaching of Japan Abstract, there is no teaching of salt crystals used as a scrub. In fact, the use of these salts in solution actually teaches away from the approach of the invention. Such a teaching away from the approach used in the invention negates any *prima facie* case of obviousness. In re Hedges, 228 U.S.P.Q. 685 (Fed. Cir. 1986). Similarly, Biener '432 teaches the use of such salts in an aqueous solution, as in the Example, where a 12% by weight aqueous solution is used (column 4, line 52).

Therefore, there is no incentive to combine the references and modify them to produce the claimed invention, in which the salts remain in “granular form” during application of the salts to the skin. The absence of such motivation, which is required for the existence of a *prima facie* case of obviousness, negates such a *prima facie* case. *In re Napier*, 34 U.S.P.Q. 2d 1782 (Fed. Cir. 1995).

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

2. The Rejection Over Stavroff et al. ‘145 in View of Steward ‘313

Claims 14, 15, and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Stavroff et al. ‘145 in view of U.S. Patent No. 5,922,313 to Steward (“Steward ‘313”).

It is well established that a rejection under 35 U.S.C. § 103(a) for obviousness must be withdrawn when one of the references relied on for the rejection is negated by the filing of a properly presented affidavit or declaration under 37 C.F.R. § 1.131 where the affidavit or declaration shows that the Applicant was in possession of as much as was taught by the reference. *In re Stryker*, 168 U.S.P.Q. 372 (C.C.P.A. 1971); *In re Dardick*, 196 U.S.P.Q. 834 (C.C.P.A. 1974). Accordingly, Stavroff et al. ‘145 is removed as a reference for these obviousness rejections.

Steward ‘313 alone does not provide sufficient information, in the absence of Stavroff et al. ‘145, to make these claims obvious. In particular, Steward ‘313 fails to teach the use of Dead Sea salts as a cleaning agent in a cosmetic composition as recited in these claims.

Accordingly, the Examiner is respectfully requested to withdraw this rejection in view of the antedating of Stavroff et al. ‘145 by the Lewis Declaration.

3. The Rejection of Claims 14-18 Over Stavroff et al. '145 in View of Steward '313 and Further in View of Chodosh '870

Claims 14-18 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Stavroff et al. '145 in view of Steward '313 and further in view of U.S. Patent No. 5,827,870 to Chodosh ("Chodosh '870").

This rejection is again respectfully traversed because Stavroff et al. '145 has been removed as a reference by the Lewis Declaration.

Chodosh '870 teaches an antimicrobial composition that is aqueous based and preferably contains a quaternary ammonium compound. Chodosh '870 does not teach or suggest the use of Dead Sea salts in any composition.

Accordingly, this rejection cannot be maintained unless Stavroff et al. '145 is used as a reference, and the Examiner is therefore respectfully requested to withdraw it

4. The Rejection of Claims 14-18 Over Kligman (GB) in View of Japan Abstract and Biener '432 Alone or in Combination, and Further in View of Chodosh '870

Claims 14-18 were rejected under 35 U.S.C. § 103(a) as unpatentable for obviousness over Kligman (GB) in view of Japan Abstract and Biener '432 alone or in combination, and further in view of Chodosh '870.

This rejection is respectfully traversed because there is no basis for combining the references. The argument stated above with respect to the rejection over Kligman (GB) in view of Japan Abstract and Biener '432 alone or in combination applies here as well. There is no incentive to combine these references and modify their teachings so that the salts are used in a granular form as required by these claims. Chodosh '870 does not teach or suggest the use of Dead Sea salts in granular form in such compositions; the use of pumice or silica, taught by

Chodosh '870, must be distinguished from the use of granular Dead Sea salts. The teachings of Chodosh '870 are too general to provide sufficient guidance to one of ordinary skill in the art for the use of Dead Sea salts in granular form.

Accordingly, the Examiner is therefore respectfully requested to withdraw these rejections under 35 U.S.C. § 103(a).

IV. CONCLUSION

In conclusion, claims 14-18, remaining for consideration, particularly point out and distinctly claim that which Applicant regards as his invention. These claims are neither anticipated by nor obvious over the references of record, in light of the Lewis Declaration. Accordingly, prompt allowance of these claims is respectfully requested.

Respectfully submitted,



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Date: October 4, 2001

Enclosure: Copy of the Clarke decision

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APPENDIX

MARKED UP AMENDED CLAIMS TO SHOW CHANGES

Claims 14 and 16-18 are amended as follows:

14. (Twice amended) A composition comprising Dead Sea mineral salts, for selectively exfoliating or scrubbing skin, the composition including a moisturizing and non-oily base element, the base element being [a non-oily] an element for retaining the mineral [salt elements] salts in granular form during use of the composition on skin, whereby the granules are effectively exfoliating or scrubbing agents on skin.

16. (Twice amended) A composition as claimed in claim 14, [wherein the] further comprising a scrubbing agent that includes silica or pumice.

17. (Once amended) A composition as claimed in claim 14 further comprising safflower oil, lipocol, glycerin and propylene glycol.

18. (Three times amended) A composition comprising:

- (a) water;
- (b) a moisturizing and non-oily base element; and
- (c) [at least one of] silica or pumice;

wherein the base element is a non-oily element for retaining the silica or pumice in a form to effectively act as an exfoliating or scrubbing agent on skin [for selectively exfoliating or scrubbing skin, the composition including a moisturizing and non-oily base element, the base element being a non-oily element for retaining the silica or pumice, in a form to effectively act as exfoliating or scrubbing agents on skin].